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In re Application of
KAVALLARIS et al.
U.S. Application No. 10/549,831
PCT No.: PCT/AU04/00331

Int. Filing Date: 18 March 2004

Priority Date: 18 March 2003

Attorney Docket No.: 69544-2

For: DETERMINING DRUG RESISTANCE

DECISION ON REQUEST

This decision is issued in response to applicants' "Petition to Correct Inventorship in Patent Application (under 37 CFR 1.48(a)(1))" filed 30 November 2006, which is being treated as a Request under 37 CFR 1.497(d). The \$130 petition fee has been charged to counsel's deposit account.

BACKGROUND

On 18 March 2004, applicants filed international application no. PCT/AU04/00331 which claimed a priority date of 18 March 2003. The international application named Maria Kavallaris as an applicant/inventor. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 18 September 2005.

On 16 September 2005, applicants filed a transmittal letter for entry into the national stage accompanied by, *inter alia*: the requisite basic national fee; a copy of the international application; and a preliminary amendment.

On 08 June 2006, the United States Designated/Elected Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 30 November 2006, applicants filed a "Petition to Correct Inventorship in Patent Application (under 37 CFR 1.48(a)(1))" which included declaration executed by: Maria Kavallaris and Nicole Verrills.

DISCUSSION

As defined in 37 CFR 1.9(a)(3), a U.S. national stage application must first comply with the requirements of 35 U.S.C. 371(c) to constitute a “nonprovisional” application, therefore, applicants’ request will be treated under 37 CFR 1.497(d). The present submission seeks to correct the inventorship so as to add inventor Nicole Verrills to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17; and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).
- (4) any new oath or declaration required by paragraph (f) of this subsection.

Applicants have satisfied items (1); (2); (3) and (4).

CONCLUSION

The request under 37 CFR 1.497(d) is **GRANTED**.

A review of the application papers reveals that applicants have completed all the requirements of 35 U.S.C. 371 for entry into the national stage. This application will be given an international application filing date of 18 March 2004 and a date of **30 November 2006** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

The application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision.



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